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| 09/881,815      | 06/18/2001  | Ta-Ching Pong        | PONG3002/BEU        | 9271             |

23364 7590 07/11/2006

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| EXAMINER |
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| ART UNIT | PAPER NUMBER |
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2623

DATE MAILED: 07/11/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

|                              |                                      |                                       |  |
|------------------------------|--------------------------------------|---------------------------------------|--|
| <b>Office Action Summary</b> | <b>Application No.</b><br>09/881,815 | <b>Applicant(s)</b><br>PONG, TA-CHING |  |
|                              | <b>Examiner</b><br>Ngoc K. Vu        | <b>Art Unit</b><br>2623               |  |

**-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --**

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 28 April 2006.
- 2a) ☒ This action is **FINAL**.                      2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-8 and 11-15 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-8 and 11-15 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- |   |   |
|---|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)                        | 4) <input type="checkbox"/> Interview Summary (PTO-413)                     |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)    | Paper No(s)/Mail Date. _____  |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| Paper No(s)/Mail Date _____   | 6) <input type="checkbox"/> Other: _____                                    |

***Response to Arguments***

1. Applicant's arguments filed 4/28/06 have been fully considered but they are not persuasive.

With respect to claims 1, 2, 7, 14, and 15, applicant argues that neither the Jeannin reference nor the Kitsukawa reference discloses or suggests updating of advertisements inserted into interactive programs, based on user responses to program content. This argument is not persuasive.

As addressed in the previous Office Action, Jeannin discloses that the inserted advertisement comprises only visual data but may also comprise audio and other types of data, is typically not displayed until specifically requested to be displayed. For example, when the user sees an object of interest about which he/she wishes to have additional information, such as the frame shown in figure 4 that displays a car with trees in the background, the user may point to and click on the object of the interest with a pointer device. The user's click causes the information about the object to be accessed and displayed on display if there is an ad (see 0037). From this view, the system provides the most relevant information associated with the selected object of interest when the user clicks on the object of the interest. It is noted that the object of interest is a part of content of the displayed program. Thus, the system of Jeannin allows the user to interact with the program being displayed for providing further advertising information in response to user's selection. Accordingly, the advertisement inserted into interactive program is updated based on responses to the content of program being submitted by the user.

In response to applicant's argument, with respect to claims 1-3, 6-8 and 11-15, that the references fail to show certain features of applicant's invention, it is noted that the features upon

which applicant relies, i.e., "insertion of advertisements into a program based on viewer reactions to program content"; "insertion of advertisements into an interactive program based on selection of multiple program paths"; insertion of advertisements into an interactive program based on responses submitted by the user, via an interface device, to the main program"; "insertion of advertisements into an interactive program based on responses submitted by the user, via an interface device, to either the main program or to previously inserted advertisement" are not recited in the rejected claim(s). Although the claims are interpreted in light of the specification, limitations from the specification are not read into the claims. See *In re Van Geuns*, 988 F.2d 1181, 26 USPQ2d 1057 (Fed. Cir. 1993).

In response to applicant's arguments with respect to claims 3-6, 8, 11 and 13 against the references individually, one cannot show nonobviousness by attacking references individually where the rejections are based on combinations of references. See *In re Keller*, 642 F.2d 413, 208 USPQ 871 (CCPA 1981); *In re Merck & Co.*, 800 F.2d 1091, 231 USPQ 375 (Fed. Cir. 1986).

Therefore, the rejections of claims are maintained for the above reasons.

### ***Claim Rejections - 35 USC § 103***

2. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

3. Claims 1, 2, 7, 14 and 15 are rejected under 35 U.S.C. 103(a) as being unpatentable over Jeannin et al. (US 20020083469 A1) in view of Kitsukawa et al. (US 6,282,713 B1).

Regarding **claim 1**, Jeannin discloses a method of delivering advertising (e.g., 290, 291 – see figure 9) to a user via composite images (e.g., 310 – see figure 9) displayed to the user through a media display device (viewing device 10 – see abstract; page 2, 0030 and figure 1) comprising the steps of: displaying a program (displaying an audiovisual program, e.g., tennis game – see figure 9); and inserting, while said program is being displayed, an advertisement into a selected portion of the displayed program, said advertisement being displayed in a manner appropriate to the content of the displayed program (for example, an advertisement, i.e., 290 and/or 291, is inserted into a selected portion of the displayed audiovisual program, the advertisement being displayed in a manner appropriate to the content of the displayed audiovisual. For example, the advertisement 290, 291 is placed alongside a tennis court 300 of the displayed tennis program – see figure 9 and page 3, 0033), wherein the advertisement is updated based on responses to the content, the responses to the content being submitted by the user via an interface device (the inserted advertisement comprises only visual data but may also comprise audio and other types of data, is typically not displayed until specifically requested to be displayed. For example, when the user sees an object of interest about which he/she wishes to have additional information, such as the frame shown in figure 4 that displays a car with trees in the background, the user may point to and click on the object of the interest with a pointer device. The user's click causes the information about the object to be accessed and displayed on display (see 0037). From this view, the system provides the most relevant information associated with the selected object of interest when the user clicks on the object of the interest. It is noted that the object of interest is a part of content of the displayed program. Thus, the system of Jeannin allows the user to interact with the program being displayed for providing further advertising information in response to user's selection.

Accordingly, the advertisement inserted into interactive program is updated based on responses to the content of program being submitted by the user).

Jeannin discloses that the program is an interactive video program (see 033-0034). Jeannin does not specifically teach the program having several possible paths, the paths being determined by responses by the user to the program content. However, Kitsukawa teaches that a television program scene 902 is displayed along with coupon information alerts 920-924 as shown in figure 9. When the user selects a coupon mode, coupon information is provided for items 910-914 in the program scene 902. In the displayed program scene 902, coupon information is available for the shoes 912 by selecting the corresponding shoe icon 922, coupon information is available for the clothing 914 by selecting the corresponding clothing icon 924...etc (see figure 9; col. 13, lines 32-41; col. 12, lines 56-65). Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify the system of Jeannin by providing different coupon information for corresponding items in the program in response to user's selection as taught by Kitsukawa in order to effectively enhance the television program.

Regarding **claim 2**, Jeannin discloses the step of inserting said advertisement comprises the step of merging a simulated image into the program (e.g., embedding or inserting a simulated object into the audiovisual program – see page 3, 0033).

Regarding **claim 7**, Jeannin discloses the advertisement is updated in real time (e.g., presenting the further information of the inserted advertisement when the user clicks on the selected object – see page 3, 0037).

Regarding **claim 14**, Jeannin discloses a system of delivering advertising (e.g., 290, 291 – see figure 9) to a user via composite images (e.g., 310 – see figure 9) displayed to the user through a media display device (viewing device 10 – see abstract; page 2, 0030 and

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figure 1), comprising: means for displaying a program (displaying an audiovisual program, e.g., tennis game – see figure 9); and means for inserting, while said program is being displayed, an advertisement into a selected portion of the displayed program, said advertisement being displayed in a manner appropriate to the content of the displayed program (as shown in figure 9, an advertisement, i.e., 290 and/or 291, is inserted into a selected portion of the displayed audiovisual program, the advertisement being displayed in a manner appropriate to the content of the displayed audiovisual. For example, the advertisement 290, 291 is placed alongside a tennis court 300 of the displayed tennis program – see figure 9 and page 3, 0033), and wherein said advertisement is updated based on responses to a previously inserted advertisement, said responses being submitted by the user via an interface device (the inserted advertisement comprises only visual data but may also comprise audio and other types of data, is typically not displayed until specifically requested to be displayed. For example, when the user sees an object of interest about which he/she wishes to have additional information, such as the frame shown in figure 4 that displays a car with trees in the background, the user may point to and click on the object of the interest with a pointer device. The user's click causes the information about the object to be accessed and displayed on display (see 0037). From this view, the system provides the most relevant information associated with the selected object of interest when the user clicks on the object of the interest. It is noted that the object of interest is a part of content of the displayed program. Thus, the system of Jeannin allows the user to interact with the program being displayed for providing further advertising information in response to user's selection. Accordingly, the advertisement inserted into interactive program is updated based on responses to the content of program being submitted by the user).

Jeannin discloses that the program is an interactive video program (see 033-0034).

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Regarding **claim 15**, Jeannin discloses the step of inserting said advertisement comprises the step of merging a simulated image into a broadcast program (e.g., embedding or inserting a simulated object into an audiovisual program – see page 3, 0033).

#### ***Claim Rejections - 35 USC § 103***

4. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

5. Claims **3-6** are rejected under 35 U.S.C. 103(a) as being unpatentable over Jeannin et al. (US 20020083469 A1) in view of Kitsukawa et al. (US 6,282,713 B1) and further in view of Wilf et al. (US 6,208,386 B1).

Regarding **claim 3**, Jeannin discloses *embedding or inserting the simulated object into the audiovisual program* (see page 3, 0033). Jeannin does not explicitly disclose using “blue



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screen" technology for the step of merging. However, Wilf teaches using chroma-key or blue screen technology for electronically replacing a real billboard in a video image display by the replacement billboard. By use of the chroma-key technology there is no requirement to transmit any occlusion data since this can be readily inserted at a receiver and the occlusion inserted in the normal manner (see col. 3, lines 39-42; col. 4, lines 21-24 and 30-32; col. 5, lines 6-20 and 46-47; col. 14, lines 29-33).

Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made to modify the combined system of Jeannin and Kitsukawa by using the chroma-key or blue screen technology for replacing a portion of the video image, i.e., real billboard in the video image, by a replacement portion, i.e., replacement billboard, at the receiver as taught by Wilf for the advantage of inserting an image into a video image at the receiver with less cost.

Regarding **claim 4**, the combination teaching of Jeannin and Kitsukawa as modified by Wilf further includes that application of the blue screen technology involves adding blue coloring to portions of a real-life environment (Wilf discloses that the billboard to be replaced is blank and is of colour suitable for chroma-key replacement such as blue— see Wilf: col. 5, lines 53-55).

Regarding **claim 5**, the combination teachings of Jeannin, Kitsukawa, and Wilf disclose that real-life environment is a sports venue (for example, Jeannin shows a tennis game in figure 9), and said blue-painted portions of the real-life environment are areas on which advertisements would normally be displayed, including areas of billboards (for example, Wilf discloses that in an arrangement within a stadium or other sport venue real billboards with normal advertising material will be situated on one side of the stadium to be viewed by a first

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plurality of cameras and chroma-key billboards will be situated on another or the opposite side to be viewed by a second plurality of cameras – see col. 5, lines 10-15).

Regarding **claim 6**, the combination teachings of Jeannin, Kitsukawa, and Wilf fail to show that a real life environment is a musical event. However, the combination teaching of Jeannin and Wilf is used in a real life environment such as a tennis game wherein advertisements are displayed on background of the event by using blue screen technology (see Jeannin: figure 9, and Wilf: col. 3, lines 39-42; col. 4, lines 21-24 and 30-32; col. 5, lines 6-20 and 46-47; col. 14, lines 29-33). In view of this, Official Notice is taken that it is well known in the art to use the combined system as taught by Jeannin, Kitsukawa, and Wilf for a musical event to present advertisements on the background of the stage. Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made to present advertisements on a background of a stage in a musical event for the desirable benefit of providing the advertisements to a wider range of audiences.

6. Claims **8** is rejected under 35 U.S.C. 103(a) as being unpatentable over Jeannin et al. (US 20020083469 A1) in view of Kitsukawa et al. (US 6,282,713 B1) and further in view of Tanabe et al. (US 20010027559 A1).

Regarding **claim 8**, Jeannin does not explicitly disclose that the advertisement is updated by advertisement sponsor. However, Tanabe teaches that the advertiser can update the contents of the advertising information any time when the need arises, so that the viewer can view the latest advertising information. Tanabe further discloses that the advertiser can update the contents of advertising information (see page 3, 0032; page 4, 0059; page 10, 0146). Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made to modify the combined system of Jeannin and Kitsukawa by updating

the advertisement by advertiser when the need arises as taught by Tanabe et al. to allow the viewer viewing the latest advertising information.

7. Claim 11 is rejected under 35 U.S.C. 103(a) as being unpatentable over Jeannin et al. (US 20020083469 A1) in view of Kitsukawa (US 6,282,713 B1) and in view of Stautner et al. (US 6,172,677 B1).

Regarding claim 11, Jeannin does not explicitly disclose the feature that the user is given the option of performing on-line or off-line transactions in response to the advertisements. However, Stautner shows in figure 2 a Pizza Hut advertisement including telephone number for the user makes an order anytime at anywhere. The user can select icon 40 to place an order on-line. By selecting icon 40, an automated sequence of events performed by the computer would then extract a proper telephone number from the data base, dial the particular number and place the users in a situation where they are in voice contact with the pizza restaurant or alternatively, provide for an automatic selection of the specifications of their desired pizza (see figure 2 and col. 5, lines 25-28; col. 6, lines 50-59). Therefore, it would have been obvious to one of ordinary skill in the art to modify the combined system of Jeannin and Kitsukawa by providing a telephone number in an advertisement for the users to order the product anytime at anywhere, or automatically dialing that number by selecting an icon to allow the users in voice contact with an operator to make an order as disclosed by Stautner in order to allow the users the option to order the product right away or later in a such convinced manner.

8. Claim 12 is rejected under 35 U.S.C. 103(a) as being unpatentable over Jeannin et al. (US 20020083469 A1) in view of Kitsukawa (US 6,282,713 B1) in view of Gautier (US 6,618,858 B1).

Regarding claim 12, Jeannin does not explicitly disclose a login process including the steps of determining an identity and location of the user; organizing the identity and location

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information into a suitable information packet; and storing the packet in the user's computing device or in computing devices located in the premises of the provider. However, Gautier teaches that when a viewer logs onto services through an advanced set-top-box (ASTB), the viewer enters a TV name which is used to identify that viewer's account or identity locally on the ASTB. The viewer also enters a PIN and a service he/she wants to access. This information is then used on the local ASTB to retrieve a UID. The UID along with other information is transmitted over the network to the MSO. The MSO uses the UID to retrieve any information it needs to process the viewer's requests (see figure 3; col. 7, lines 21-36 and col. 7-8, lines 61-4). Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify the combined system of Jeannin and Kitsukawa by including login process as taught by Gautier in order to verify the viewer identification for accessing the service.

9. Claim 13 is rejected under 35 U.S.C. 103(a) as being unpatentable over Jeannin et al. (US 20020083469 A1) in view of Kitsukawa (US 6,282,713 B1) and Stautner et al. (US 6,172,677 B1) and further in view of Tomsen (US 20020016965 A1).

Regarding claim 13, the combination teaching of Jeannin and Stautner et al. does not explicitly disclose the steps of permitting the user to select whether to accept updating of the user's computing device. However, Tomsen teaches that a television commercial displays a prompt that asks the viewer whether the viewer wishes to "Buy now" or "Buy later". If the viewer clicks the "Buy now" selection in response to the prompt, then additional commands can be sent from the set top box to the participating merchant to allow the viewer to conduct and complete the transaction. If the viewer clicks the "Buy later" selection in response to the prompt, then the transaction is deferred. Deferral of the transaction includes saving information in the set top box (see page 4, 0034-0037). Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made to modify the combination teaching of Jeannin,

Kitsukawa and Stautner by permitting the user to select whether to accept updating of the user's computing device, i.e., order an advertised product now or later, as taught by Tomsen in order to allow the viewer begin a transaction to order the advertised product, or save information related to that television commercial in a convenience manner.

***Conclusion***

10. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Ngoc K. Vu whose telephone number is 571-272-7306. The examiner can normally be reached on Monday-Thursday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, John W. Miller can be reached on 571-272-7353. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



Ngoc K. Vu  
Primary Examiner  
Art Unit 2623

July 9, 2006